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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/585,872

10/10/2007

Jean-Yves Le Gendre

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12/03/2009

OLIFF & BERRIDGE, PLC

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ALEXANDRIA, VA 22320-4850

EXAMINER

KENNEDY, NICOLETTA

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

12/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,872	Applicant(s) LE GENDRE ET AL.	
	Examiner Nicoletta Kennedy	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/14/06 and 7/11/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-20 are currently pending.

Election/Restrictions

1. Applicant's election with traverse of the invention of Group II, claims 2-20 as presently amended in the reply filed on August 28, 2009 is acknowledged. The traversal is on the ground(s) that unity of invention is not broken by US/2003/0235553 because the application does not teach one specific embodiment comprising a film comprising a coloring agent. Applicants' remarks are acknowledged, however, in view of the prior art applied below in the instant office action, the special technical feature of claim 1 does not make a contribution over the prior art and therefore the technical feature recited in claim 1 is not special. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 1 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on August 28, 2009.

3. Claims 2-20 are under consideration.

Priority

This application, filed July 11, 2006, is a national stage entry of PCT/FR05/50035, filed January 21, 2005 and claims priority to provisional application 60/541,238, filed February 4, 2004. Applicants also claim priority to French application 0450109, filed January 21, 2004 in France. Applicants have provided a certified copy of this document.

4. This application claims benefit to provisional application No. 60/541,238, filed on February 4, 2004, in a language other than English. An English translation of the non-English language provisional application and a statement that the translation is accurate must be filed in provisional application No. 60/541,238. See 37 CFR 1.78(a)(5). The translation and statement required by 37 CFR 1.78(a)(5) are missing. Accordingly, applicant must supply 1) the missing translation and statement in provisional application No. 60/541,238 and 2) in the present application, a confirmation that the translation and statement were filed in the provisional application. If 1) and 2) are not filed (or the benefit claim withdrawn by the filing of an amendment or Supplemental Application Data Sheet) prior to the expiration of the time period set in this Office action, the present application will be abandoned. See 37 CFR 1.78(a)(5)(iv).

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 9-12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lydzinski et al. (US 2003/0099692) (pub. May 29, 2003) in view of Fellows et al. (US 4,925,667) (pub. May 15, 1990).

Regarding claims 9 and 20, from which claims 2-14 depend, Lydzinski et al. teach a film comprising starch as the main component (abstract). The starch is modified (para. 0005) to dissolve or disintegrate quickly when exposed to water or an aqueous fluid, such as when placed in the oral cavity or on the tongue (para. 0010). The film may be used to deliver a variety of agents to the skin, including anti-aging agents and

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moisturizers (para. 0036). The film contains some water but the amount of water may be controlled (para. 0031). The method of delivering the active ingredient is to apply the composition to an animal (claims 26). The film is then dissolved when contacted with water or saliva. However, Lydzinski et al. fail to teach the water content of the film. Fellows et al. cure this deficiency.

Fellows et al. teach cosmetics, including lipstick, in the form of a film (abstract). The film is comprised of cosmetic particulates such as coloring agents (column 3, lines 60-68 and column 5, lines 39-46). The film forming agent is preferably a water-soluble polymer (column 4, line 28). The slurry is dried, leaving an anhydrous film (column 6, lines 3-13). The cosmetic may be applied with a finger, commercial brush or foam applicator (column 5, lines 14-18). The final film forming agent provides only weak adhesion between the particulate and the substrate so that rubbing one's finger across the exposed microcapsulated cosmetic surface will remove the cosmetic from the substrate (column 4, lines 20-24).

It would have been prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Lydzinski et al. with those of Fellows et al. to teach a method of applying an anhydrous film lipstick dissolved by applying the action of saliva and rubbing. One would have been motivated to do so because Lydzinski et al. teach a cosmetic film activated to dissolve when placed in contact with saliva. Fellows et al. teach an anhydrous film that is transferred to a substrate and applied to the lips. As with any lip gloss or lip stick, the wearer ensures uniform distribution of the color by either rubbing the lips with a finger or by rubbing the

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lips together. This also allows uniform distribution of the saliva that activates the film taught by Lydzinski et al.

Regarding claim 2, Fellows et al. teach that the film forming agent may be polyvinyl pyrrolidones (column 4, lines 15). One would have been motivated to substitute starch for polyvinyl pyrrolidone because Fellows et al. teach that both may be used as film forming agents (column 4, lines 12-17).

Regarding claims 10-12, Lydzinski et al. teach that the film may be comprised of benzophenone-3, a protectant against solar radiation (para. 0091).

10. Claims 3-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lydzinski et al. (US 2003/0099692) (pub. May 29, 2003) in view of Fellows et al. (US 4,925,667) (pub. May 15, 1990) as applied to claims 2, 9-12 and 20 above, and further in view of Lu et al. (US 2003/0235553) (pub. Dec. 25, 2003).

The combination of Lydzinski et al. and Fellows et al. teach each element of claim 20 but fail to teach the specific coloring agents that may be used in an anhydrous lipstick. Lu et al. cure this deficiency.

Regarding claims 3-6, Lu et al. teach an anhydrous lipstick film (para. 0244) wherein the coloring agent may be a pigment or water-soluble dye such as methylene blue or beetroot juice (paras. 0494 and 0495).

It would have been prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Lydzinski et al. and Fellows et al. with those of Lu et al. to teach use a pigment or water-soluble dye such as methylene

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blue or beetroot juice as a coloring agent. One would have been motivated to do so because Lydzinski et al. and Fellows et al. teach that the film may comprise a coloring agent and may be used as a cosmetic. Lu et al. teach that an anhydrous film may be used as a lipstick and may comprise a pigment or water-soluble dye as the coloring agent.

Regarding claims 7 and 15, Lu et al. teach that the anhydrous film comprises a pigment used as a coloring agent and that the pigment may be goniochromatic (paras. 0244 and 0496).

Regarding claim 8, Lu et al. teach that the coloring agent is present from 0.01 to 50% relative to the total weight of the composition (para. 0494). MPEP 2144.05 states that “[i]n the case where the claimed ranges ‘overlap or lie inside ranges disclosed by the prior art’ a *prima facie* case of obviousness exists” quoting *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). In the instant case, the claimed range overlaps the range taught by the prior art and is therefore *prima facie* obvious.

11. Claims 13-14 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lydzinski et al. (US 2003/0099692) (pub. May 29, 2003) in view of Fellows et al. (US 4,925,667) (pub. May 15, 1990) as applied to claims 2, 9-12 and 20 above, and further in view of Tan et al. (US 6,511,672) (pub. Jan. 28, 2003).

The combination of Lydzinski et al. and Fellows et al. teach each element of claim 20 but fail to teach the specific active ingredients. Tan et al. cure this deficiency.

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Regarding claims 13-14 and 16-19, Tan et al. teach a cosmetic composition that may be in the form of an anhydrous lipstick or lip gloss (column 6, lines 59-66). The active ingredient may be an alpha-hydroxy acid or a beta-hydroxy acid (column 7, line 52). The active ingredient may also be generally an anti-wrinkle agent, wound-healing agent which have a softening, healing, or regenerating action aimed at smoothing the surface of the skin (or lips, in the case of lipstick) (column 7, lines 33-65). Finally, the active ingredient may include retinoids such as retinol and esters, acids and aldehydes thereof (column 7, lines 48-50).

It would have been prima facie obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Lydzinski et al. and Fellows et al. with those of Tan et al. to use alpha or beta hydroxyl acid or an anti-wrinkle or wound-healing agent as the active agent in an anhydrous lip film. One would have been motivated to do so because Lydzinski et al. and Fellows et al. teach that the film may comprise an active ingredient such as an anti-aging compound. Tan et al. teach specific active ingredients that may perform this action or that otherwise improve the appearance of the lips.

Specifically regarding claims 14 and 19, although Fellows et al. teach the use of a particulate substrate to deliver the film via the mail (i.e. to place in a magazine), Lydzinski et al. teach that while the film can be prepared on a substrate (para. 0030), the film need not be (para. 0029).

Conclusion

No claims are allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicoletta Kennedy whose telephone number is (571)270-1343. The examiner can normally be reached on Monday through Thursday 8:15 to 6:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Gollamudi Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. K./

Examiner, Art Unit 1611

/David J Blanchard/

Primary Examiner, Art Unit 1643